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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/719,278

11/21/2003

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26166

3203

27256

7590

06/30/2006

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EXAMINER

FERNSTROM, KURT

ART UNIT

PAPER NUMBER

3711

DATE MAILED: 06/30/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/719,278	Applicant(s) CHARLES ET AL.	
	Examiner Kurt Fernstrom	Art Unit 3711	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-28 is/are allowed.
- 6) ☒ Claim(s) 29-31 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 29-31 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

According the recently published "Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility" (1300 OG 142, 22 November 2005), the analysis for determining patent eligible subject matter under §101 can be said to be subject to the following criteria:

1. Does the claimed invention fall within one of the four statutory categories (process, machine, manufacture or composition of matter)? If the answer to this criterion is no, then the claimed invention is not statutory eligible subject matter.
2. If the answer is yes to the first criterion, then does the claimed invention fall within a judicial exception? If the answer to this criterion is no, then the claimed invention would be statutory eligible subject matter.
3. If the answer is yes to the second criterion, then does the claimed invention provide a practical application of the judicial exception? If the answer to this criterion is yes, then the claimed invention would be statutory eligible subject matter, unless the claimed invention effectively preempts all substantial practical applications of the judicial exception, in

which case the claimed invention would not be statutory eligible subject matter.

4. If the answer to the third criterion is no, then the claimed invention is not statutory eligible subject matter and is not eligible for patent protection.

With regards to the first criterion, the invention of claims 29-31 is a graphic display of data. These claims appear to fail to meet the first criterion, as no machine, manufacture or composition of matter appears to be clearly recited. A "graphic display", with no clearly recited substrate or other tangible object, amounts to no more than a recitation of abstract ideas. Because claims 29-31 fail to recite a process, machine, manufacture or composition of matter, the subject matter of these claims is not statutory subject matter.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 29-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over admitted prior art. Applicant has acknowledged that dental charts are generally well known, with Figures 5A-5B and 6A-6B provided as examples. As noted above, the claims are directed merely to graphic displays. It is well settled that patentability cannot rest on the content of printed matter, where there is no new and nonobvious functional

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relationship between the printed matter and the underlying substrate. See *In re Gulack* (CAFC) 217 USPQ 401 and *In re Ngai*, 70 USPQ2d 1862 (CA FC 2004). Here, the differences between the claimed invention and the admitted prior art reside merely in the content and arrangement of graphic indicia, and thus do not give rise to patentability. Further, the charts of Figure 5A, which discloses boxes located between indicia representing teeth, and Figure 6A, which discloses 2 rows of boxes corresponding to upper and lower teeth, when viewed in combination suggest the chart of claims 29 and 30. The limitations of claim 31 are also considered to be an obvious variation on the teachings of the admitted prior art, as it is known to chart the inside and outside surfaces of teeth.

Allowable Subject Matter

Claims 1-28 are allowed.

The following is a statement of reasons for the indication of allowable subject matter: The prior art fails to disclose or suggest a method having all of the limitations of the claims. In particular, there is no disclosure or suggestion of taking the steps of taking first and second measurements as recited, and graphically displaying the differences between the measurements as recited in the claims. While various types of dental charts are well known, these charts generally reflect the condition of teeth and gums as measured once. There is no suggestion of displaying the **difference** between two measurements as claimed. The claimed method has a discrete purpose, as it

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enables the user to view the results of varying treatments, and thus is distinguishable from the prior art and is allowable.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Chester, Serabian-Musto, Stenz, Shapiro, Fish, Bush, "All Pets Dental: The Dental Chart", "Family Gentle Dental Care", "Perio Dental Chart" and "Innobate Dental Chart View" disclose various dental charts and displays.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kurt Fernstrom whose telephone number is (571) 272-4422. The examiner can normally be reached on M, T, Th 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gene Kim can be reached on 571 272-4463. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

KF
June 22, 2006


KURT FERINSTRON
PRIMARY EXAMINER